Remarks

The above Amendments and these Remarks are in reply to the Office Action mailed January 26, 2007. A Petition for Extension of Time is submitted herewith, together with the appropriate fee.

I. Summary of Examiner's Rejections

Prior to the Office Action mailed January 26, 2007, Claims 1-65 were pending in the Application. In the Office Action, Claims 1-65 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-11, 13-19, 21-31, 33-38, 50-54, 56 and 58-65 were rejected under 35 U.S.C. § 102(e) as being anticipated by Andivahis et al. (U.S. Patent No. 7,146,009, hereinafter Andivahis). Claims 12, 20, 32, 39, 40-49, 55 and 57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Andivahis in view of Shirai et al. (U.S. Patent No. 6,466,968). The Office Action also mentioned Gilmour et al. (U.S. Patent No. 6,154,783), however based on the citations on pages 16-17 of the Office Action, Applicant assumes that the rejection under 35 U.S.C. § 103(a) was intended to be over the Shirai reference.

II. Summary of Applicant's Amendment

The present Response amends 1, 2, 12-13, 16, 18, 19, 21, 23, 32, 35, 37-38, 40, 43, 46, 49, 50, 54-55, 58-59, 60, 62, and 64, and cancels Claim 61, leaving for the Examiner's present consideration Claims 1-60 and 62-65. Reconsideration of the Application, as amended, is respectfully requested. Applicant respectfully reserves the right to prosecute any originally presented or canceled claims in a continuing or future application.

III. Claim Rejections under 35 U.S.C. § 101

In the Office Action mailed January 26, 2007, Claims 1-65 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, it was cited that the steps of these claims failed to definitely recite a hardware executing the computer software, rendering the claim as recited only an abstract idea.

The present Response hereby amends Claims 1, 2, 12-13, 16, 18, 19, 21, 23, 32, 35, 37-38, 40, 43, 46, 49, 50, 54-55, 58-59, 60, 62, and 64 so as to more clearly define the embodiments therein. Claim 61 is canceled. Applicant respectfully submits that as amended, Claims 1-60 and

62-65 now comply with the requirements of 35 U.S.C. §101 and reconsideration thereof is respectfully requested.

IV.   Claim Rejections under 35 U.S.C. § 102(e)

In the Office Action mailed January 26, 2007, Claims 1-11, 13-19, 21-31, 33-38, 50-54 and 58-65 were rejected under 35 U.S.C. § 102(e) as being anticipated by Andivahis et al. (U.S. Patent No. 7,146,009, hereinafter Andivahis).

Claim 1

Claim 1 has been amended to more clearly define the embodiment therein. As amended, Claim 1 defines:

> 1.   A computer implemented method for modifying a list of permitted senders used by electronic mail (email) access control devices, said method comprising:
> under control of a sender:
> accepting a recipient identifier;
> providing sender information along with a petition provider identifier to a recipient, the recipient having an access list of permitted senders associated therewith;
> under control of the recipient:
> providing the sender information to a petition provider identified by the petition provider identifier;
> accepting an access list petition request (petition) from the petition provider, said petition being stored in a computer readable storage medium;
> determining whether the petition is acceptable based on at least one of: 1) a sender identity verification method; 2) user input; and 3) third party information; and
> modifying said access list of permitted senders of the recipient such that the sender is added to said access list if the petition is determined to be acceptable;
> wherein the petition is received and evaluated at a time the sender receives recipient's email address and prior to transmission of email messages between said sender and said recipient; and
> wherein the petition is transmitted through a different protocol than said email messages in order to avoid said petition from being filtered.

As amended, Claim 1 defines a method for modifying lists used by email access control devices. The list is modified at the time of subscription and prior to any email communication between the sender and recipient. Once the recipient receives an access list petition request from

a provider, it can determine whether that petition is acceptable and modify the list by adding the sender to it. As such, Claim 1 features can make sure that the access list (e.g. address book and safe sender list) are updated reliably and automatically at the time that the recipient subscribes to a newsletter from the sender, for example.

The features of Claim 1 address the problem of a recipient signing up for a newsletter and then having to remember to add the recipient's email address to their "whitelist" or "access list" (often implemented as the recipient's address book or safe sender list) to make sure the email gets delivered. Often a recipient will sign up for a newsletter and then neglect to update their list (which is done via the email program that may not be in use at the time of signing up). This can cause the sender's email messages to get filtered with spam control. The features of Claim 1 can allow the access list to be automatically and reliably updated so as to prevent such inconveniences.

Andivahis teaches a secure electronic messaging system requiring key retrieval for deriving decryption keys. More specifically, Andivahis appears to disclose a system of encrypting and decrypting email message transmission between several users by use of a key server (Andivahis, Abstract). Furthermore, Adivahis also appears to describe sender authentication during the message transmission (col. 16 line 57 – col. 17, line 24)

However, Applicant respectfully submits that Andivahis fails to anticipate the features defined in Claim 1.

Firstly, Andivahis fails to disclose *modifying the access list of permitted senders* of the recipient such that the sender is added to the access list if the petition is determined to be acceptable, as defined in amended Claim 1. Andivahis is not concerned with a method for modifying lists of permitted senders. Instead, Andivahis describes an access control device which checks sender authentication at the time that the email message is being sent (col. 16, line 57 – col. 17, line 24). Thus, rather than modifying any lists (as in Claim 1), Andivahis encrypts/decrypts messages and authenticates users during the actual message transmission.

Andivahis does include a way to check if the sender's account is current (col. 4, lines 46-64). However, this is entirely different from access lists used for spam control by ISPs and mail software, as defined in Claim 1. For example, in Claim 1, an access list is associated with a particular recipient and enumerates the permitted senders for that recipient, rather than merely specifying whether an account is valid. Furthermore, with access lists, general email from the

entire internet must be received and delivered, not just a finite set of registered users, as disclosed in Andivahis.

Secondly, Andivahis fails to disclose that the petition is received and evaluated *prior to the transmission of email messages between the sender and the recipient*, as defined in amended Claim 1. On the contrary, Andivahis describes a system that controls the encryption/decryption of email messages at the time of message transmission. Claim 1, on the other hand, does not address sender verification at the time of transmission (as in Andivahis), rather, the petition is something that is done prior to any messages being sent. For example, the petition of claim 1 is <u>not</u> included as part of the email message and it is not transmitted via the SMTP protocol, since it must not be subject to spam filters which may discard it. Rather, the petition is received and evaluated through a second communication channel (i.e. not via an email message) and <u>before</u> transmission of any email messages between the sender and recipient.

Thirdly, (and related) Andivahis fails to disclose that the petition is transmitted through a different protocol than the email messages in order to avoid the petition from being filtered, as defined in amended Claim 1. As discussed above, if the petition was sent via SMTP, it may be caught by the spam filter. Therefore, because the petition is sent at a time prior to any email transmissions, it can be sent via a different protocol than the messages and thus avoid being rejected by any filter at the recipient side.

Fourthly, Andivahis fails to disclose that the petition is received and evaluated at the time the sender receives the recipient email address, (such as in a subscription to a newsletter), as defined in amended Claim 1. This allows the verification of recipient's authority to update the access list by either the recipient directly or automatically by virtue of recipient credentials stored on the recipient's computer. None of this functionality is disclosed in Andivahis, since its main concern appears to be encryption/decryption of email messages.

Finally, Andivahis fails to disclose an access list petition request that is defined in Claim 1, as amended. Instead, Andivahis teaches a public key request that is sent to the key server. Such a request for a public decryption key is not the same as a petition to update the recipient's access list, as defined in Claim 1.

In view of the above comments, Applicant respectfully submits that Claim 1, as amended, is neither anticipated by, nor obvious in view of the cited references, and reconsideration thereof is respectfully requested.

Claims 21, 50, 60 and 62

Claims 21, 50, 60 and 62, while independently patentable, recite limitations that, similarly to those described above with respect to claim 1, are not taught, suggested nor otherwise rendered obvious by the cited references. Reconsideration thereof is respectfully requested.

Claims 2-11, 13-19, 22-31, 33-38, 51-54 and 58-59

Claims 2-11, 13-19, 22-31, 33-38, 51-54 and 58-59 are not addressed separately, but it is respectfully submitted that these claims are allowable as depending from an allowable independent claim, and further in view of the comments provided above. Applicant respectfully submits that Claims 2-11, 13-19, 22-31, 33-38, 51-54 and 58-59 are similarly neither anticipated by, nor obvious in view of the cited references, and reconsideration thereof is respectfully requested.

It is also submitted that these claims also add their own limitations which render them patentable in their own right. Applicant respectfully reserves the right to argue these limitations should it become necessary in the future.

Claim 61

Claim 61 has been canceled, thereby rendering moot any rejection as to this claim. Reconsideration of the application, as amended, is respectfully requested.

V.   Claim Rejections under 35 U.S.C. § 103(a)

In the Office Action mailed January 26, 2007, Claims 12, 20, 32, 39, 40-49, 55 and 57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Andivahis in view of Shirai et al. (U.S. Patent No. 6,466,968). The Office Action also mentioned Gilmour et al. (U.S. Patent No. 6,154,783), however based on the citations on pages 16-17 of the Office Action, Applicant assumes that this rejection is over the Shirai reference. Review of this rejection by Examiner is respectfully requested.

In the Office Action, Shirai was cited as teaching an email access list for acceptable credentials (Office Action, page 16-17). However, Applicant respectfully submits that the "access list" disclosed in SHIRAI contains a list of users who may read a file and not a list of

permitted senders who are allowed to send email to a specific recipient, as defined in the claims of the present Application. More importantly, SHIRAI completely fails to disclose how the access list is maintained. For example, SHIRAI fails to disclose that the access list is modified by adding the sender in real time, i.e. that the petition is received and evaluated at a time the sender receives recipient's email address and prior to transmission of email messages. Furthermore, SHIRAI also fails to disclose that the petition is transmitted through a different protocol than the email messages to avoid the petition from being filtered by spam filters, as defined in amended Claim 1.

Accordingly, Applicant respectfully submits that the features of Claims 12, 20, 32, 39, 40-49, 55 and 57 are not disclosed in SHIRAI in combination with Andivahis and reconsideration thereof is respectfully requested.

VI. Conclusion

In view of the above amendments and remarks, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and reconsideration thereof is respectfully requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including June 26, 2007.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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